

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 60

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte JAN R. COYLE

NOV 28 1995

Appeal No. 94-3458
Application 07/912,221¹

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

HEARD: May 8, 1995

Before KRASS, CARDILLO, and BARRETT, Administrative Patent Judges.

CARDILLO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal taken under 35 U.S.C.
§ 134 from the examiner's rejection of claims 1-13, the only
claims in this application.

¹Application for patent filed July 10, 1992. According to applicant, the application is a continuation of Application 07/794,325, filed November 12, 1991; a continuation of Application 07/471,051, filed January 18, 1990; a continuation of Application 07/368,137, filed June 16, 1989; a continuation of Application 07/262,068, filed October 24, 1988; a continuation of Application 06/928,930, filed November 10, 1986; and a continuation-in-part of Application 06/854,329, filed April 21, 1986, Abandoned.

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The invention relates to a system for transforming sonic signals, in terms of increasing, maintaining or decreasing impedance thereto, wherein the transformation potentiometer is in the sonic signal path between the headphone output of one device and the microphone or recorder input of a recording device. We reproduce illustrative claim 1, as follows:

1. A system for playback or transcription of sonic signals comprising means for feeding sonic signals through sonic signal headphone output means; means for transforming said sonic signals for input to sonic signal microphone input means or sonic signal recording means, said transforming means including means for increasing, maintaining or decreasing the impedance to sonic signals from said headphone output means; means for passing sonic signals from said headphone output means to said signal transforming means; and means for passing sonic signals from said signal transforming means, with or without adjustment of the impedance to said signals, to said sonic signal microphone input means for to said sonic signal recording means.

REFERENCES

There are no references of record relied upon by the examiner.

The references of record relied upon by the Board pursuant to 37 CFR § 1.196(b) are:

Huth	2,186,072	Jan. 09, 1940
Giampapa	4,048,444	Sep. 13, 1977

The reference not of record relied upon by the Board pursuant to 37 CFR § 1.196(b) is:

Pavel	4,412,106	Oct. 25, 1983
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THE EXAMINER'S REJECTION

Claims 1 to 13 stand rejected under 35 U.S.C. § 101 as lacking utility.

Rather than repeat the detailed positions of the appellant or the examiner, we make reference to the brief² and the answer for the details thereof.

OPINION

After a careful review of the record before us, we find that the rejection of claims 1-13 under the utility requirement of § 101 must be reversed. However, we apply new grounds of rejection relative to claims 1, 2 and 4-13 pursuant to 37 CFR § 1.196(b) as set forth, infra.

The examiner appears to have focused upon the existence of impossible to achieve advantages set forth in the specification. In so doing, the examiner has not come to grips with real question of concern as to the § 101 utility of the claimed invention in terms of its clearly discernable function of connecting the headphone output of one device to an input of a recording device. Consequently, even though we agree with the examiner that there can be no adjustment of the level of a signal using a potentiometer that can be said to improve the "signal-to-

²The examiner has denied entry of the reply brief, see Paper No. 57.

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noise ratio" (as set forth at page 2, lines 18-26, and page 3, lines 5-9, of the specification), this disclosed but unclaimed impossibility is not determinative of the question of whether the claimed invention has § 101 utility. Likewise, even though we are of the view that brief description of Fig. 3 (also on page 3); page 4, line 25; page 5, lines 3-6 and the description of potentiometer adjustment of lines 21-25 of page 4 of the specification are further clearly erroneous in repeating the impossibility noted above as well as adding further impossibilities as to improving fidelity and/or quality by adding a noise inducing element (potentiometer) to a signal path, such unclaimed impossibilities are again not dispositive here.

What is dispositive to us is the fact that the invention claimed is in the domain of predictable electrical devices where the very nature of what has been claimed indicates that a useful result is achieved. Thus, the self evident utility of the claimed "means for transforming" and "means for passing" (in terms of coupling a signal from a signal output of one device to a signal input of another device) cannot be ignored merely because the specification (not the claims) appears to defy well established scientific doctrines. Clearly, this is not a situation where the unpredictable nature of a claimed chemical

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composition dictates that the specification must set forth some kind of utility not apparent from the claims themselves.

We have considered the examiner's position set forth in the incorporated portion of Paper No. 30. However, the examiner's position appears to us to boil down to the concern that appellant's claimed coupling arrangement is inferior to the known connection of audio source line outputs to standard recording device line inputs. However, there is no § 101 utility requirement that the source to recorder coupling result achieved by the claimed invention must be at least as good or better than any similar coupling result achieved following prior art practices. Instead, to support a rejection based upon an alleged lack of § 101 utility, the examiner must demonstrate that the claimed subject matter is totally incapable of achieving any useful result. Note Brooktree Corp. v. Advanced Micro Devices, Inc., 977 F.2d 1555, 24 USPQ2d 1401 (Fed. Cir. 1992).

Consequently, while the case law is clear that had the impossible to achieve above-noted advantages been recited in the claims the rejection thereof under the utility requirement of 35 U.S.C. § 101 (or the first paragraph of § 112) would have been proper, it is equally clear that such limitations cannot be imported into the claims from the specification. Raytheon Co. v. Roper Corp., 724 F.2d 951, 220 USPQ 592 (Fed. Cir. 1983), cert.

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denied, 469 U.S. 835 (1984). Moreover, the implications of the appealed claims and of lines 4-17 of page 1 of the specification as to the claimed subject matter having utility in terms of merely coupling a signal between two devices cannot be ignored. Thus, although we agree with the examiner that the invention (as claimed) must have utility in terms of being able to perform at least one objective of the invention (note the bottom of page 2 of the answer as well as the cases cited in Raytheon on this point at 724 F.2d at 959, 220 USPQ at 598), we disagree with the examiner's apparent position that such is not the case as to the above-noted coupling between two devices.

In reaching our conclusion that the claimed subject matter before us has § 101 utility in terms of providing a path for signals between a source device output and a recording device input, we have also considered the examiner's further position of Paper No. 30 as to the appellant's invention merely introducing a problem and correcting it. The examiner characterizes this as being, in effect, a nonevent. The first problem with this approach is that it ignores the above-noted utility clearly present as to the claimed establishment of a signal path. Secondly, the argument presumes a specific potentiometer setting to provide a specific offsetting gain which is not expressly claimed.

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In this last regard, we note that the claims cover all possible potentiometer settings and not simply ones needed to provide any specific compensation. Moreover, claims 1-9 are not limited to which recorder input must be used. Thus, we find no merit in the examiner's apparent reading of specific impedance requirements into much broader claim language just as we find no merit in appellant's approach as to assuming that what has been disclosed in the Avery declarations (see EXHIBITS C-E of the main brief), as to adding harmonics related to flattening of signal peaks, is an express part of the claimed subject matter. In fact, the harmonic additions of these declarations are not even hinted at in the application as filed.³

Moreover, we are not convinced of the probative value of the noted declarations because none of them set forth what the exact subject matter under test was. Thus, we do not consider it to be sufficient that these declarations refer to "Mr. Coyle's sound processing device" or "Coyle's device" without any description of the components of that device. In addition, it is not clear that the tests were of the same scope as the subject matter of appealed claims 1-9 because, as we discuss, infra, the

³Clearly, a description found only in a declaration may not be used as augmentation of what was contained in the application as filed. In re Buchner, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991).

placement of the transforming means of these claims is not limited to being only between the headphone output of a source and the microphone input of a recorder which was, apparently, the only tested configuration. Furthermore, it is not clear where the instant specification recognizes the importance of the "non-linear nature of the change produced in the preamplifier" noted in paragraph 13 (D) of page 5 of EXHIBIT C.

Nevertheless, given that we have found the examiner has not established a prima facie case as to a lack of § 101 utility of the claimed subject matter, the inadequacies in appellant's proffered rebuttal evidence are considered to be moot.⁴

NEW GROUNDS OF REJECTION
37 CFR § 1.196(b)

Claims 5, 7 and 10-13 are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite.

⁴We note in passing that we agree with the examiner that the above-noted assertions of the specification as to improved signal-to-noise ratios, fidelity and/or quality appear to us to be incredible and that the proffered declaration evidence has no bearing as to proving such incredible assertions to be, in fact, true. Consequently, we see nothing in the further fact that there is an acceptable § 101 signal coupling utility present that would preclude the examiner from requiring the deletion of all unproven assertions of such incredible utility from the specification. In re Citron, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963) ("statements of utility deemed incredible or misleading must be either removed or proved . . . notwithstanding there may be present in the application other proper and acceptable assertions of utility").

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The inquiry to be made concerning indefiniteness under the second paragraph of § 112 is to determine whether the claims do, in fact, set out and circumscribe "a particular area with a reasonable degree of precision and particularity when read by the artisan in light of the disclosure and the relevant prior art. See In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). Here, claims 5, 7 and 12-13 require us to indulge in speculation and conjecture as to appellant's intended subject matter coverage such that we have no recourse but to so reject these claims.

Claim 5 depends from claim 4 and, consequently, includes the subject matter of this parent claim. See 37 CFR § 1.75(c). However, the claim 5 recitation of "wherein the microphone input means is a video cassette recorder" makes no sense in light of the parent claim 4 recitation that the "microphone input means [of ultimate parent claim 1] are the microphone input means of a sonic signal playback and record means" It is not clear to us if appellant's intent as to claim 5 was to in effect claim the "video cassette recorder" therein as a specific type of claim 4 "sonic signal playback and record means" (as was done in claims 11 and 13) or if appellant actually intended to make this claim depend from claim 1 and somewhat mirror claim 4 by specifying that the "microphone

input means" of claim 1 was the "microphone input means" of "a video cassette recorder."

Claim 7 is even more confusing because it depends on claim 5 and, thus, includes this claim 5 conjecture as well as lacking antecedent basis for the recited "said separate sonic signal playback and record means" Once again we must indulge in speculation and conjecture in terms of whether appellant intended to make claim 7 depend from claim 6 (which has antecedent basis for "a separate sonic signal playback and record means") or whether appellant intended to refer only to claim 4 and, thus, to a "said sonic signal playback and record means" Additionally we are left to ponder whether the reference to claim 5 was perhaps intended but that the "separate sonic signal playback and record means" language was inadvertently copied from claim 6 instead of the claim 5 "video cassette recorder."

Claims 10 and 12 have similar problems as to how to interpret the initial recital of "sonic signal microphone input means of sonic signal recording means" in light of the final recital of "passing sonic signals" to the "sonic signal microphone input means or to said sonic signal recording means" This last noted alternative recital makes it appear that perhaps the first noted recital was intended to also be

alternative ("of" should have been "or") which would make these claims more in line with claim 1 and mean that we should interpret the "sonic signal recording means" as an alternative input to the "microphone input means." Such an interpretation is additionally attractive because it is consistent⁵ with the disclosed alternatives ("microphone input means or recording input means") of pages 2 (lines 14-15 and 25-26) and 3 (lines 6-7) of the specification. However, such an interpretation is at the same time unattractive because it does violence to the clear intent of dependent claims 11 and 13 that treat the "sonic signal recording means" of the parent claims as being separate devices (each is recited to be a "video cassette recorder") and not inputs ("of" was indeed intended and the final "or" is accordingly erroneous). Once again, we are left to speculate and

⁵The Moore decision requires that claim language be considered in light of "the particular application disclosure." This is more fully explained in footnote 2 (439 F.2d at 1235, 169 USPQ at 238) with respect to seemingly definite and clear claim language taking on an unreasonable degree of uncertainty when that which appears to be claimed is not consistent with what has been described in the application disclosure. In addition, this footnote includes a specific reference to In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971) which states that "[n]o claim may be read apart from and independent of the supporting disclosure upon which it is based" and, as a consequence of such a reading, mandates that any "inexplicable inconsistency within each claim . . ." as to the "description, definitions and examples appearing in appellant's specification, . . ." requires a finding that such claims must be considered indefinite.

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guess as to the meets and bounds of what appellant intended to encompass where such conjecture does not satisfy the mandate of the second paragraph of § 112 as to ensuring that the claims will:

provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.

In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

Claims 11 and 13 depend from claims 10 and 12 and therefore include the indefinite limitations thereof.

Claims 1, 2, 4, 6, 8 and 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Pavel in view of Huth and Giampapa.

Pavel teaches the claimed "system for playback or transcription of sonic signals" because it teaches that the system disclosed therein should advantageously include a recording device of the type described at col. 15, lines 50-56. This recording device is further taught to be for recording audio (sonic) signals supplied by a "program source, the microphones 7, or by an auxiliary input." This teaching at least suggests that there are standard separate inputs for microphones and inputs for

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receiving signals from other sonic signal sources associated with the recording device as well as standard recording level or gain control associated with these recorder inputs (such as noted in claims 6 and 9). It is well settled that such implications to the artisan must be considered as part of that which a reference fairly suggests. Note In re Shepard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963).

Accordingly, we consider that the artisan would have found it to have been obvious in a § 103 sense to have such multiple inputs for the recording device and to couple a signal to be recorded to at least one of them. Moreover, the artisan would have found the use of conventional recording level control circuitry to have been obvious as a well established expedient with recording devices like those suggested by Pavel.

Pavel also suggests to the artisan that "transforming means" including "potentiometer means" for increasing, maintaining or decreasing an impedance to sonic signals should be provided along with "headphone output means," see col. 12, lines 45-50 and note that the teaching of a balance control and volume control would have implied the use of a potentiometer type controlled impedance to the worker of ordinary skill in the art. While Pavel's preferred embodiment is taught as including such balance and volume controls with the amplifiers of device 2,

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Pavel also suggests that any such circuitry can be advantageously modularized and coupled to other modules at col. 17, lines 4-18. Clearly, such unpreferred but nevertheless suggested embodiments are to be considered as fair reference suggestions to the artisan even if they have not been illustrated or described in detail. Note In re Bode, 550 F.2d 656, 193 USPQ 12 (CCPA 1977).

One coupled module approach is taught by Huth as advantageously including a volume control (11,7) within a headphone plug module as well a separate balance control with the headphones. See Figs. 5 and 6 and note col. 1, line 53 - col. 2, line 17 of page 1 of Huth. The inclusion of such a volume control headphone plug module (with or without the headphone balance control) to mate with the output of module 2 of Pavel (note col. 12, lines 48-50) would, thus, have been suggested by these reference teachings considered together as a modification to the preferred embodiment of Pavel.

Clearly, after this modification, Pavel suggested mixing circuitry (col. 13, lines 57-66), loudness compensation and limiting circuitry (col. 14, lines 9-16) and, if desired, balance control, would still remain with the amplifier section and function to adjust "the gain of sonic signals," in claim 6 and claim 8 terms.

Although Pavel does not specifically teach how the signals monitored by the headphones will be supplied to any particular recorder input, the suggestion that this is to be done under a variety of recording circumstances is clear. See col. 5, lines 54-63, col. 6, lines 60-62, col. 8, lines 7-16⁶ and col. 18, lines 21-30. Accordingly, the claimed "means for passing sonic signals from said signal transforming means . . . to said sonic signal microphone input means or to said sonic signal recording means"⁷ is at least hinted at relative to these

⁶We note in passing that this suggested recording device would clearly fall within the category of a video recording device as would that of col. 16, lines 12-20.

⁷As can be inferred from our previous rejection, we do not consider the claims on appeal to be models of clarity. However, when we read claim 1 and the claims dependent thereon in light of the specification (note again Moore and Cohn) it appears to us to be relatively certain that the occasional omission of the modifier "sonic" from before the term "signal" (see, for example, original claim 1 at line 9, "said signal" should be "said sonic signal") and the occasional omission of "sonic signal" from before "recording means" (note the end of claims 2 and 3) are inadvertent errors that do not impede our understanding of the subject matter being claimed. While the claim 1 recital of a "sonic signal recording means" might appear to read on a recording device when read in a vacuum, its true nature as an input means to a recorder like the "microphone input means" becomes clear upon consideration of the alternative nature ("or") of these two claimed "means" and the supporting disclosure of two alternative inputs noted above. Our reading of the alternative "sonic signal recording means" as another "recording input means" is, thus, mandated by the need to be consistent with the specification as well as the requirement of 37 CFR § 1.175(d) (1) as to the claims conforming to the invention set forth in the remainder of the specification.

suggestions. Moreover, Fig. 5 of Giampapa teaches that a headphone signal being monitored is easily recorded by the simple expedient of feeding it from the monitoring headphones to the inputs of a standard recorder by direct coupling wires 32 and 34. Note col. 6, lines 16-20 of Giampapa. Note also that Pavel has suggested monitoring body sounds like those of Giampapa relative to the biofeedback-auditory monitoring discussion of col. 15, lines 24-34. Accordingly, the above-noted teachings of Giampapa would have led the artisan to further modify the Pavel-Huth system for the Pavel suggested recording of headphone signals by directly coupling the headphones to at least one set of the available recorder inputs.

In light of the foregoing, the decision of the examiner is reversed. Note, however, that new grounds of rejection have been applied as to claims 1, 2 and 4-13.

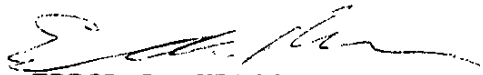
Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of this decision (37 CFR § 1.197). Should appellant elect to have further prosecution before the examiner to the new rejections under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened


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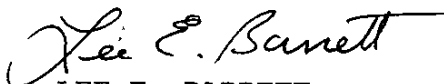
statutory period for making such response is hereby set to expire
two months from the date of this decision.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED-37 CFR § 1.196(b)


ERROL A. KRASS)
Administrative Patent Judge)


RAYMOND F. CARDILLO, JR.)
Administrative Patent Judge)


LEE E. BARRETT)
Administrative Patent Judge)

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Patrick F. Bright
Bright and Lorig
633 West 5th Street
Suite 3330
Los Angeles, CA 90071